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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,693	10/17/2003	Edward Flory	27475/06642	2692

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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT PAPER NUMBER

3676

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/605,693	Applicant(s) FLORY ET AL.	
	Examiner Suzanne Dino Barrett	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.  
     4a) Of the above claim(s) 1-18,24 and 25 is/are withdrawn from consideration.  
 5) ☒ Claim(s) 19-23 is/are allowed.  
 6) ☒ Claim(s) 26-31 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. Claims 30,31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, the recitation that “the lock remains locked while the combination is changed” is inconsistent with the language in claim 26, lines 5-6, which recites that the combination is changed (line 5), then in the next step, the key is turned back to the locked position (line 6). Likewise in claim 30, wherein the recitation in the last line that “the lock remains locked while the combination is changed” is inconsistent with the language in line 6 which recites changing the combination and the subsequent step in line 8 which recites “turning the key back to the locked position”. It is not understood how the lock can remain in the locked position while changing the combination, if it's claimed as being *turned back* to the locked position *after* changing the combination.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

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In the instant case, there are two new claims numbered 30. Accordingly, under 37 C.F.R. §1.126, the second misnumbered claim 30 has been renumbered 31.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 26,28, and 30,31 as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Walby 6,708,538. Walby teaches a combination lock having a dial 18 with a key cylinder 20/16 and dial cam arrangement 32A mounted

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therein and wherein the key and cam 32A (tumbler dial) provide the combination changing means. The combination is changed (col.8, lines 1-14) by rotating the key to decouple the dial pin 38 on number dial 18 from the cam (tumbler dial) drive holes 40 to allow rotation of the number dial 18 to a new position indicated by a marker on the front face of the dial 18. The claimed method steps are considered inherent to the use of the combination changing means as set forth in Figures 22-26 and col.7, line 36 - col.8, lines 1-14.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walby '538 in view of Hermann 3,383,886. Walby fails to teach an offset key cylinder lock. Hermann teaches a combination dial and key cylinder lock wherein the key cylinder 6/8 is offset from the combination dial center portion 1,2. It would have been obvious to modify the shape of the combination dial to provide an offset key cylinder hole as taught by Hermann as an obvious matter of design choice.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walby '583 in view of Bell 2,035,781. Walby teaches the lock discussed above and further teaches the use of spring biased ball bearings 64A as a coupling means, but not for the

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number dial and tumbler dial. Bell teaches a similar lock comprising spring biased ball bearings 40 (Fig.8,9) to provide a coupling means between a number dial 29 and tumbler dial assembly 7/22 (page 3, lines 17-34). It would have been obvious to substitute the ball bearings coupling means and push-in dial as taught by Bell, for the pin and hole coupling means and pull-out dial of Walby as an obvious matter of design choice in enhancing the engagement between the elements by providing a spring bias.

***Allowable Subject Matter***

8. Claims 19-23 are allowed.

***Response to Arguments***

9. Applicant's arguments with respect to claims 26-31 have been considered but are moot in view of the new ground(s) of rejection.

Firstly, it is noted that Applicant's arguments pertaining to claims 19-23 are persuasive and these claims have now been indicated as allowable.

Secondly, the presentation of new claims 26-31 raises new issues under 35 USC §112 and 35 USC §102, as set forth above.

Thirdly, Applicant has failed to present arguments regarding new claims 26-31 with respect to the previously applied prior art rejection. Accordingly, claims 26-31 stand finally rejected as set forth above.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Suzanne Dino Barrett', with a stylized flourish at the end.

Suzanne Dino Barrett  
Primary Examiner  
Art Unit 3676

sdb